APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,945	07/07/2000	RUDOLF RITTER	PM271464	4546

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EXAMINER
D AGOSTA, STEPHEN M

ART UNIT	PAPER NUMBER
2684	

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

Office Action Summary	Application No. 09/582,945	Applicant(s) RITTER, RUDOLF
	Examiner Stephen M. D'Agosta	Art Unit 2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

       1.☒ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____ .

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
          application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *1,2* .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Specification

Applicant is reminded of the proper language and format for an <u>abstract</u> of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

<u>**Claims 1-3, 5-15 and 17-19**</u> rejected under 35 U.S.C. 103(a) as being

unpatentable over Yoshinobu U.S. Patent 5,684,526 further in view of Jonstromer U.S.

Patent 6,142,369 and Diehl et al. U.S. Patent 5,173,589 (hereafter referred to as

Yoshinobu, Jonstromer and Diehl).

As per **claims 1 and 14,** Yoshinobu teaches a two-way broadcast telecommunications method (title) comprising:
Receiving by means of a suitable telecommunications mobile device (figure 2 #300 and figure 3), which contains a receiver (figure 2 shows RF link between #300 and

#400 via #301 transmitter), digital data sent over a broadcast channel which data are transmitted as program-accompanying data in a media program (C2, L56-65)

Displaying information corresponding to the received digital data on a display of the mobile device (figure 3, #302)

Entering a command by the user (figure 3, #320 shows buttons used to enter a command)

Preparing a message corresponding to the entered command, the prepared message including at least one data field from the digital data received and an identification of the user (figure 3, #325 and C7, L5-14)

Sending the prepared message over a mobile radio network (C8, L12-30)

But is silent on:

A radio and/or television receiver

the telecommunications mobile device including an identification card by which the user of the telecommunications device is identified AND determined from the identification card.

The examiner points out that the wireless device in figure 2 communicates with an "interface system" (#400) which acts as the intermediary device between the wireless device and the television/telephone systems. One skilled in the art would be able to move the components of the interface system to the wireless device so that it can communicate directly with the TV/radio broadcast and phone network as needed.

Jonstromer teaches a mobile phone that uses a smart/SIM card which identifies the user (C1, L27-44).

Diehl teaches a process for instantaneous confirmation of actions in relation to television programs and device for use of the process (title) that teaches a receiver (figure 1, #3) and smart card reader which are used to interact with the television program (C2, L31-67 to C3, L1-56). Diehl teaches direct reception and interaction with the TV show but does not teach the "receiver" as being a mobile device (whereas Yoshinobu does).

With further regard to claim 14, Yoshinobu does teach that the mobile device has a display/LCD which one skilled in the art would use to reproduce said media program. The examiner also points out that the applicant states mobile radio apparatus with an adequate screen (eg. video phone) are commercially available and one skilled in the art can easily integrate a TV tuner in such mobile device (page 4, L19-29).

It would have been obvious to one skilled in the art at the time of the invention to modify Yoshinobu, such that the device has a radio/TV receiver and ID Card and can display the media program, to allow a user to directly receive the broadcast for viewing and allow the user to uniquely identify themselves to the media program (eg. for shopping).

As per **claim 2**, Yoshinobu teaches claim 1 **but is silent on** wherein said media program is reproduced by the telecommunication mobile device.

Yoshinobu does teach that the mobile device has a display/LCD which one skilled in the art would use to reproduce said media program.

The examiner also points out that the applicant states mobile radio apparatus with an adequate screen (eg. video phone) are commercially available and one skilled in the art can easily integrate a TV tuner in such mobile device (page 4, L19-29).

It would have been obvious to one skilled in the art at the time of the invention to modify Yoshinobu, such that the device can reproduce the media program, to provide the user means to receive the broadcast directly for viewing without the need for a TV set.

As per **claim 3**, Yoshinobu teaches claim 1 wherein the user uses a remote control transmitter to view and select a response (C5, L56-65) [eg. displayed information contains at least one menu from which a command can be selected].

As per **claim 5**, Yoshinobu teaches claim 1 wherein remote control transmitter (figure 4) contains RAM/ROM (#313/#312) that can be used to store data which is received **but is silent on** when the processing/displaying components are turned off, the data received are temporarily stored in a buffer and not processed until these components are turned on.

The examiner points out that the ability of the device to receive/store data while certain components are switched off is a design choice and one skilled in the art would be able to provide this service as the amount of memory permits.

It would have been obvious to one skilled in the art at the time of the invention to modify Yoshinobu, such that the mobile device can receive/store data if processing/displaying components are turned off, to provide means for the user to receive data even if they are not present to receive it and/or have the unit turned off.

As per **claim 6**, Yoshinobu teaches claim 1 **but is silent on** wherein the digital data received are packed in messages which are first evaluated in order to determine whether they must be displayed.

The examiner points out that the processing of data received has many possibilities, including FIFO, LIFO, etc.. The examiner points out that the way in which data is processed in a design choice since there are several possibilities that exist, each of which have their merits depending upon the situation/user environment. Yoshinobu is interpreted to provide FIFO processing since it is an interactive system that prefers action as a message is received.

It would have been obvious to one skilled in the art at the time of the invention to modify Yoshinobu, such that data is evaluated in order to determine whether they must be displayed, to provide an "evaluation step" that determines whether the message(s) are important enough to be displayed or not.

As per **claim 7**, Yoshinobu teaches claim 1 **but is silent on** wherein the received message which are not of interest to the user are sorted out with the aid of a user profile stored in memory of the mobile device.

Jonstromer teaches a SIM Card in a mobile phone that stores a variety of information about a mobile telephone subscriber and the services they are entitled to (C1, L29-32) which is similar to a user profile. (NOTE: The data in a SIM card can be downloaded to the mobile unit's RAM memory).

Since Yoshinobu discloses a myriad of uses for responding to two-way broadcast programs such as a quiz show, TV shopping, polling surveys, audience participation, etc. (C1, L20-28), one skilled in the art would ensure that a message which is not of interest to a user is sorted based on the user profile stored in the memory/SIM of the mobile device.

It would have been obvious to one skilled in the art at the time of the invention to modify Yoshinobu, such that messages are sorted based on the user's profile, to ensure that the most user-preferred messages are shown and those not of interest (based on the user profile) are discarded or placed at the end.

As per **claim 8**, Yoshinobu teaches claim 1 **but is silent on** wherein the digital data are transmitted in a radio channel.

Yoshinobu discloses TV and radio broadcasts (C1, L14-27) and hence, one skilled in the art would use a radio channel to transmit the digital data.

While Yoshinobu teaches a two-way broadcast system that support TV broadcasts (figure 1, #100), the data is not sent directly to the mobile unit, but rather, through an interface unit. One skilled in the art would remove the interface unit (figure 2, #400) and add radio-receiving components to the mobile unit so that it can transmit/receive directly.

It would have been obvious to one skilled in the art at the time of the invention to modify Yoshinobu, such that the data is received/transmitted in a radio channel, to provide the user the ability to receive/transmit data from TV, radio or other broadcast means.

As per **claim 9**, Yoshinobu teaches claim 1 **but is silent on** wherein the digital data are transmitted in a TV channel.

While Yoshinobu teaches a two-way broadcast system that support TV broadcasts (figure 1, #100), the data is not sent directly to the mobile unit, but rather, through an interface unit. One skilled in the art would remove the interface unit (figure 2, #400) and move the TV-receiving components from said interface unit to the mobile unit so that it can transmit/receive directly.

It would have been obvious to one skilled in the art at the time of the invention to modify Yoshinobu, such that the data is received/transmitted in a TV channel, to provide the user the ability to receive/transmit data from TV, radio or other broadcast means.

As per **claims 10 and 17**, Yoshinobu teaches claim 1 or 14-16 **but is silent on** wherein the prepared message is a SMS message.

Yoshinobu teaches the use of a telephone network (figure 1, "LINE" is a telephone line) which can be replaced by a cellular/wireless link. SMS messaging in cellular/wireless systems is well known and oe skilled in the art would replace the message sent from Yoshinobu's invention to an SMS message to provide a known means of sending messages from a cell phone.

It would have been obvious to one skilled in the art at the time of the invention to modify Yoshinobu, such that the prepared message is an SMS message, to take advantage of the SMS messaging capability existing today in the cellular industry.

As per **claims 11 and 18**, Yoshinobu teaches claim 1 or 14-17 **but is silent on** wherein the prepared message is a USSD message.

Yoshinobu teaches the use of a telephone network (figure 1, "LINE" is a telephone line) which can be replaced by a cellular/wireless link. SMS messaging in cellular/wireless systems is well known and oe skilled in the art would replace the message sent from Yoshinobu's invention to an SMS message to provide a known means of sending messages from a cell phone.

It would have been obvious to one skilled in the art at the time of the invention to modify Yoshinobu, such that the prepared message is an USSD message, to take advantage of the USSD messaging capability existing today in the cellular industry.

As per **claim 12**, Yoshinobu teaches claim 1 **but is silent on** wherein the prepared message is signed.

Yoshinobu teaches a REGISTER ID button on the mobile device (figure 3, #325) which registers the user with the network. This parallels the applicant's limitation of the message being signed, since a user is essentially informing the network of who they are (eg. signing a message) when they register. Other ways of "signing a message" to identify the user include the use of a Hash function, public Key and the use of a secret password/login.

It would have been obvious to one skilled in the art at the time of the invention to modify Yoshinobu, such that the prepared message is signed, to ensure the authenticity of the transmitted message.

As per **claim 13**, Yoshinobu teaches claim 1 **but is silent on** wherein the prepared message is encrypted.

Since cellular/wireless systems broadcast RF data for all to receive, one skilled in the art would provide encryption to protect a user from having personal data being stolen.

It would have been obvious to one skilled in the art at the time of the invention to modify Yoshinobu, such that the prepared message is encrypted, to ensure that the message cannot be read by anyone other than the intended recipient.

As per **claim 15**, Yoshinobu teaches claim 14 **but is silent on** wherein the mobile radio components comprise a GSM phone.

Jonstromer teaches a GSM phone (C1, L39-41).

It would have been obvious to one skilled in the art at the time of the invention to modify Yoshinobu, such that the phone is a GSM phone, to ensure that the system can be used in multiple phone systems (ie. AMPS, D-AMPS, CDMA, TDMA/FDMA, GSM, etc.).

As per **claim 19**, Yoshinobu teaches claim 14-18 wherein there is a display (figure 3, #302).

Claims 4 and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over

Yoshinobu and Jonstromer as applied to claims 14 or 15 above, and further in view of

Alperovich et al. U.S. Patent 6,138,002.

As per **claim 4**, Yoshinobu teaches claim 1 wherein the remote control transmitter contains a microcomputer/CPU which can store/execute any program (C7, L22-35) **but is silent on** wherein the digital data can contain applets which are executed by the mobile device.

Alperovich teaches a system for providing services based on broadcasted information (title) and that the SIM card could include a JAVA platform which allows the BSS to send a JAVA script containing the time period application and counter application to the MS, which can then be run on the SIM card (C5, L9-17).

It would have been obvious to one skilled in the art at the time of the invention to modify Yoshinobu, such that the mobile can execute applets, to provide the user means for receiving a program downloaded by the media program to allow the user to interact with said media program (eg. the program may download a specific software application that must for the user to use for shopping, etc.).

As per **claim 16**, Yoshinobu teaches claim 14 or 15 **but is silent on** wherein the ID card is a SIM card capable of executing the applets transmitted in the program-accompanying data.

Jonstromer teaches a GSM phone that uses a SIM card (C1, L28-44). The examiner notes that a SIM card can store any type of data (including JAVA Applets).

Alperovich teaches a system for providing services based on broadcasted information (title) and that the SIM card could include a JAVA platform which allows the BSS 380 to send a JAVA script 385 containing the time period application 320 and counter application 330 to the MS 300, which can then be run on the SIM card 310 (C5, L9-17.

Conclusion

The prior art made of record and not relied upon is considered pertinent to
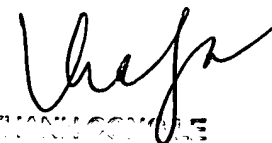
applicant's disclosure:

1. Jones U.S. Patent 5,500,681 teaches generating product coupons from TV.

2. Nickerson U.S. Patent 5,226,177 teaches real-time audience response.

3. Palmer U.S. Patent 5,438,355 teaches viewer response.

4. Suzuki U.S. Patent 5,946,026 teaches multi-broadcast receiver

5. Morales-Garza U.S. Patent 5,257,099 teaches local area audience response.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-

306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Daniel Hunter can be reached on 703-308-6732. The fax phone numbers

for the organization where this application or proceeding is assigned are 703-872-9314

for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-306-

0377.

SMD
September 25, 2002